

**REMARKS**

In the Final Office Action mailed on November 15, 2005, the Examiner rejected claims 1, 3-4, 18-23, 27-29, and 35-37 under 35 U.S.C. § 102(e) as being anticipated by *Washington*, U.S. Patent Application Publication No. US 2002/0052777. The Examiner also rejected claims 5-10 and 30-31 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "User's Guide for TurboTax and TurboTax Deluxe for Tax Year 1997" ("*TurboTax*"). The Examiner also rejected claims 11-13 and 24-26 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of "Barron's Dictionary of Business Terms, 3d Edition" ("*Barron's Dictionary*"). Finally, the Examiner rejected claims 14-17 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of *Barron's Dictionary* and *TurboTax*.

By this Amendment, Applicants propose to amend claims 1, 18, 27, and 35 to place the claims in condition for allowance.

**Section 101 Rejections**

Applicants thank the Examiner for the reconsideration and withdrawal of the previous rejections of claims 35-37 under 35 U.S.C. § 101.

**Section 102 Rejections**

Claims 1, 3-4, 18-23, 27-29, and 35-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by the *Washington* reference. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8<sup>th</sup> ed. 2001, revised August 2005). As amended, claims 1, 3-4, 18-23, 27-29, and 35-37 recite elements not disclosed by *Washington* and Applicants therefore submit that these claims are allowable over the reference.

Claim 1, as amended, recites a method including the steps of establishing a transaction before any supplier is selected for the transaction, the transaction having an associated value, and comparing, before any supplier is selected for the transaction, the transaction value with an established value threshold to determine a transaction guideline. The *Washington* reference does not teach such a method.

Instead, the reference discloses setting a project overall goal (called a "POG") for an amount of money to be awarded to disadvantaged business entities by a recipient of a government contract. (*Washington*, ¶ 0020.) For a project, sub-project goals (called "SPGs") may also be set. (*Washington*, ¶ 0024.) As the Examiner specifically noted in the Final Office Action, the reference states that "[o]nce initial values have been set for the POG...and the SPG...the recipient may then begin awarding contracts to contractors to complete sub-projects 106." (*Washington*, ¶ 0029, Final Office Action, p. 26.) Furthermore, "[a]fter contracts have been awarded to contractors...the recipient should begin to monitor spending to see whether it remains on track to meet the POG and each SPG." (*Washington*, ¶ 0030.)

According to the Examiner, the contracts described in the reference teach establishing a transaction and the amount of money paid for a contract represents an associated value of the contract. (Final Office Action, p. 3.) However, Applicants' proposed amendments clarify that the claimed transaction and its associated value are established before any supplier is selected for the transaction. Thus, the money actually spent during a project (as disclosed in the *Washington* reference and noted by the Examiner) cannot teach establishing a transaction and its associated value before any supplier has even been selected for the transaction.

Furthermore, the *Washington* reference does not teach comparing, before any supplier is selected for the transaction, the transaction value with an established threshold value to determine a transaction guideline. Instead, the reference teaches comparing “money actually paid to DBE’s” to the POG over the lifetime of a project. (*Washington*, ¶¶ 0031-0032.) The comparison disclosed in the reference occurs after suppliers have been selected and paid for performing a project. This cannot teach the step of comparing, before any supplier is selected for a transaction, a transaction value and a value threshold to determine a transaction guideline.

In the Final Office Action, the Examiner pointed to the reference teaching that “[o]nce initial values have been set for the POG...and the SPG...the recipient may then begin awarding contracts to contractors to complete sub-projects 106.” (*Washington*, ¶ 0029; Final Office Action, p. 26.) While this passage may teach setting initial goals before awarding contracts to sub-contractors, it does not teach comparing, before any supplier is selected for the transaction, a transaction value (i.e., “the money actually paid” to a DBE, according to the Examiner) with an established threshold value (i.e., the POG, according to the Examiner) to determine a transaction guideline. (Final Office Action, p. 26.)

The Examiner further stated that “the money paid to the DBE’s compared to the POG represents a prime contractor relying on a transaction guideline prior to awarding contracts to contractor for sub-projects.” (Final Office Action, p. 26.) However, Applicants’ amendments make clear that the claimed comparing occurs before any supplier is selected for the transaction. Thus, any teaching in *Washington* of a

comparison that takes place after a contractor has already been selected would not teach the claimed method.

Because the *Washington* reference fails to teach every element of amended claim 1, Applicants request the withdrawal of the section 102 rejections and the allowance of claim 1 and its dependent claims 3-5, 7-14, and 16-17.

Claim 18, as amended, recites a method including the steps of establishing a transaction before any supplier is selected, said transaction having an associated value, and comparing the transaction value with a value threshold to determine a transaction guideline before any supplier is selected for the transaction. As discussed above with respect to claim 1, the *Washington* reference does not disclose these steps or this method. Therefore, Applicants request the withdrawal of the section 102 rejections and the allowance of claim 18 and its dependent claims 19-26.

Amended claim 27 recites an apparatus comprising a monitoring system configured to compare a transaction value with a value threshold to determine a transaction guideline before any supplier is selected for the transaction. The *Washington* reference does not disclose such an apparatus for at least the reasons given above with respect to the method set forth in claim 1. Therefore, Applicants request the withdrawal of the section 102 rejections and the allowance of claims 27 and its dependent claims 28-31.

Amended claim 35 recites a method including the step of comparing a value of a transaction to a threshold value to determine a transaction guideline before any supplier is selected for the transaction. As discussed above with respect to claim 1, the *Washington* reference does not disclose this step or this method. Therefore, Applicants

request the withdrawal of the section 102 rejections and the allowance of claim 35 and its dependent claims 36-37.

### **Section 103 Rejections**

The Examiner rejected claims 5-10 and 30-31 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of *TurboTax*. The Examiner also rejected claims 11-13 and 24-26 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of *Barron's Dictionary*. Finally, the Examiner rejected claims 14-17 under 35 U.S.C. § 103(a) as being obvious over the *Washington* reference in view of *Barron's Dictionary* and *TurboTax*.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001, revised August 2005). Because the cited references, taken together or individually, do not teach or suggest every element of claims 5-17, 24-26, and 30-31, Applicants request the withdrawal of the section 103 rejections and the allowance of claims 5-17, 24-26, and 30-31.

Claims 5-10 depend from amended claim 1 and claims 30 and 31 depend from amended claim 27. Accordingly, claims 5-10 and 30-31 recite, among other things, methods and apparatus that establish a transaction before any supplier is selected for the transaction, the transaction having an associated value that is unrelated to a plurality of supplier classes. As discussed above, the *Washington* reference does not disclose or suggest this recitation. Furthermore, *TurboTax* does not cure this defect. *TurboTax* is a guide for completing a personal income tax return and is unrelated to establishing a transaction and associated value used to select a supplier. Because the

*Washington* reference and *TurboTax*, taken alone or in combination, fail to teach or suggest every element of claims 5-10 and 30-31, Applicants request the withdrawal of the section 103 rejections and the allowance of these claims.

Claims 11-13 depend from amended claim 1 and claims 24-26 depend from amended claim 18. Accordingly, claims 11-13 and claims 24-26 recite, among other things, methods including the step of establishing a transaction before any supplier is selected for the transaction, said transaction having an associated value. As discussed above, the *Washington* reference does not disclose or suggest such a method step. Furthermore, *Barron's Dictionary* does not cure this defect. *Barron's Dictionary* is merely cited for its definitions of forecasting and prediction, having to do with foretelling future events. (Final Office Action, p. 18.) This is unrelated to establishing a transaction and associated value before any supplier has been selected. Because the *Washington* reference and *Barron's Dictionary*, taken alone or together, fail to teach or suggest every element of claims 11-13 and 24-26, Applicants request the reconsideration and withdrawal of the section 103 rejections of these claims.

Claims 14-17 depend indirectly from amended claim 1 and accordingly recite, among other things, methods and apparatus that establish a transaction before any supplier is selected for the transaction, the transaction having an associated value that is unrelated to a plurality of supplier classes. As discussed above, the *Washington* reference does not disclose or suggest this recitation. Furthermore, *TurboTax* and *Barron's Dictionary* do not cure this defect. *TurboTax* is a guide for completing a personal income tax return and is unrelated to establishing a transaction and associated value used to select a supplier. Furthermore, *Barron's Dictionary* is cited for its

definitions of forecasting and prediction, having to do with foretelling future events

Because the *Washington* reference, *TurboTax*, and *Barron's Dictionary*, taken alone or in combination, fail to teach or suggest every element of claims 14-17, Applicants request the withdrawal of the section 103 rejections and the allowance of these claims.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 3-5, 7-14, 16-31, and 35-37 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 18, 27, and 35 do not raise any new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this


Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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